

DOCKET NO. AUS920000192US1

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Confirmation No.: **2382**

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REAL PARTY IN INTEREST

The real party in interest of the present application is the Assignee, International Business Machines Corporation of Armonk, New York, as evidenced by the Assignment set forth at Reel 010839/Frame 0548.

RELATED APPEALS AND INTERFERENCES

The present appeal is related to the following prior appeals of the present application:

- (1) The decision in Appeal No. 2004-1712, mailed January 28, 2005, which reversed the final rejection of Claims 2-8, 11, 12, 14-17, 20, 21, 23-26 and 28-30; and
- (2) The decision in Appeal No. 2009-003738, mailed August 31, 2009, which affirmed the final rejection of Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-30.

STATUS OF CLAIMS

Claims 1-27 were originally presented. During prosecution, Claims 1, 9-10, 13, 18-19, 22 and 27 were canceled, and Claims 28-33 were entered. Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-33, which comprise all pending claims, have been twice rejected, as noted in the Final Office Action dated May 27, 2010. The rejection of each of Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-33 is appealed.

STATUS OF AMENDMENTS

No amendment has been submitted or entered subsequent to the final rejection leading to the present Appeal.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent Claim 28 recites a method for displaying data on a portable device (see, e.g., Figures 1, 2A-2B; page 5, line 3 *et seq.* and page 6, line 3 *et seq.*) having a display (see, e.g., Figure 1, display 110; page 5, line 6 *et seq.*; Figures 2A-2B, display 210; page 6, line 7 *et seq.*) that is significantly larger in a first dimension than in a second dimension (see, e.g., Figures 2A-2B; page 6, line 12 *et seq.*). According to the method, a portable device receives a data page in the portable device (see, e.g., Figure 3, block 310; page 7, line 18 *et seq.*). The portable device analyzes the data page to determine an orientation for presentation of the data page relative to the

first and second dimensions of the display (see, e.g., Figure 3, blocks 315 and 320; page 7, line 23 *et seq.*). The portable device automatically displays the data page in a first orientation within the display in response to determining the first orientation and automatically displays the data page in a second orientation within the display in response to determining the second orientation (see, e.g., Figure 3, blocks 315 and 330; page 7, line 23 *et seq.* and page 8, line 1 *et seq.*).

Independent Claim 29 recites a portable data processing system (see, e.g., Figures 1, 2A-2B; page 5, line 3 *et seq.* and page 6, line 3 *et seq.*) including a processor (see, e.g., Figure 1, processor 105; page 5, line 6 *et seq.*), a memory coupled to the processor (see, e.g., Figure 1, memory 115; page 5, line 6 *et seq.*), and a display that is significantly larger in a first dimension than in a second dimension (see, e.g., Figure 1, display 110; page 5, line 6 *et seq.*; Figures 2A-2B, display 210; page 6, line 7 *et seq.*). Instructions in the memory (see, e.g., page 8, line 21 *et seq.*), when processed by the processor, cause the portable data processing system to receive a data page in the portable data processing system (see, e.g., Figure 3, block 310; page 7, line 18 *et seq.*), analyze the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display (see, e.g., Figure 3, blocks 315 and 320; page 7, line 23 *et seq.*), and automatically display the data page in a first orientation within the display in response to determining the first orientation and automatically display the data page in a second orientation within the display in response to determining the second orientation (see, e.g., Figure 3, blocks 315 and 330; page 7, line 23 *et seq.* and page 8, line 1 *et seq.*).

Independent Claim 30 recites a computer program product for use within a portable data processing device (see, e.g., Figures 1, 2A-2B; page 5, line 3 *et seq.* and page 6, line 3 *et seq.*) having a display that is significantly larger in a first dimension than in a second dimension (see, e.g., Figure 1, display 110; page 5, line 6 *et seq.*; Figures 2A-2B, display 210; page 6, line 7 *et seq.*). The computer program product includes a computer-readable storage medium (see, e.g., Figure 1, memory 115; page 8, line 21 *et seq.*). Instructions embodied within the storage medium that cause the portable data processing device to receive a data page within the portable data processing device (see, e.g., Figure 3, block 310; page 7, line 18 *et seq.*), analyze the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display (see, e.g., Figure 3, blocks 315 and 320; page 7, line 23 *et seq.*), and

automatically display the data page in a first orientation within the display in response to determining the first orientation and automatically display the data page in a second orientation within the display in response to determining the second orientation (see, e.g., Figure 3, blocks 315 and 330; page 7, line 23 *et seq.* and page 8, line 1 *et seq.*).

GROUND OF REJECTION TO BE REVIEWED ON THE APPEAL

The grounds of rejection to be reviewed on appeal include:

- I. the final rejection of Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-33 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, as set forth at page 4 of the Final Office Action;
- II. the final rejection of Claims 20-21, 23-26, 30 and 33 under 35 U.S.C. § 112, 1st paragraph, as failing to comply with the written description requirement, as set forth at page 4 of the Final Office Action; and
- III. the final rejection of Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-30 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,661,632 to *Register* in view of U.S. Patent No. 6,453,173 to *Reber et al. (Reber)*, as set forth at page 5 of the Final Office Action.

ARGUMENT

I. Rejection under 35 U.S.C. § 112, 1st paragraph, for lack of enablement

At page 4 of the Final Office Action, all pending claims are rejected under 35 U.S.C. § 112, 1st paragraph, as allegedly failing to enable “analyzing the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display” as recited in exemplary independent Claim 28. That rejection is not well founded and should be reversed.

As set forth in MPEP 2164.01, the enablement requirement of 35 U.S.C. § 112, 1st paragraph, mandates:

... the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”).

Further guidance regarding a determination of enablement or non-enablement is found in MPEP 2164.01(a), which states in relevant part:

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue.” These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The

examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of nonenablement must be based on the evidence as a whole.
858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

MPEP 2164.01(a), emphasis supplied.

In the statement of the rejection under 35 U.S.C. § 112, 1st paragraph, the Examiner fails to consider on the record *any* evidence related to any of the eight factors of *In re Wands*, as required by MPEP 2164.01(a). Thus, the Examiner has failed to establish a *prima facie* case of nonenablement under 35 U.S.C. § 112, 1st paragraph.

Further, if objective evidence is actually considered, those skilled in the art will quickly appreciate that the “analyzing” step of exemplary Claim 28 is clearly enabled at page 7, line 23 *et seq.* of the specification, which discloses:

The device then displays the page in the default orientation (step 315), which will be referred to as Display Mode1. The user can set the default orientation to either the wide or narrow orientation. Alternatively, the device can automatically determine the best-fit orientation for the display. By examining the line-width of the text being received, the device will determine whether the wide or narrow orientation will be used as the default orientation for that set of text.

Specification, page 7, line 23 *et seq.*, emphasis supplied. Thus, the present specification teaches that the portable device can examine the line width of the data page to determine the display orientation.

The present specification additionally teaches, for example, at page 3, line 17 *et seq.*, that the data pages presented by the portable device can be Web pages:

The preferred embodiment is particularly adapted to displaying Web data on wireless devices such as a portable telephone, wherein the Web data can be effectively displayed by flipping the display orientation between the narrow and wide dimensions of the display. The flipping between screen orientations can be selected by user action or done dynamically by the portable device itself.

Those skilled in the art at the time of the present invention well understood that the “Web data” described in the present specification was typically received at the portable device in the form of

HyperText Markup Language (HTML). See, e.g., W3C, “HTML 4.01 Specification, W3C Recommendation,” December 24, 1999, p. 1 (“This specification defines the HyperText Markup Language (HTML), the publishing language of the World Wide Web.”).

At the time of the present invention, the HTML 4.01 Specification, referenced *supra* and attached hereto, defined HTML syntax for explicitly specifying the line width of Web page elements, including text, columns, images, objects and applets. For example, the line width of text can be defined in HTML as described at page 97 in section 9.3.4; the line width of columns can be defined in HTML as described at page 113 in section 11.2.1 and again at pages 122-123; and the line width of images, objects and applets can be defined in HTML as described page 179 in section 13.7.1. Thus, those skilled in the art at the time of the present invention would readily have appreciated from the present specification that an examination of line width as taught at page 7, line 23 *et seq.* could include an examination of the underlying HTML code to determine the best orientation for presentation of the Web data given the line width specified by the HTML code.

Given the clear enabling disclosure of the present specification, particularly when read in light of knowledge well known to those skilled in the art at the time of the present invention, the present specification clearly enables a person of ordinary skill in the art at the time of the invention to make and use a portable device that “analyz[es] the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display” without undue experimentation. The rejection of all pending claims under 35 U.S.C. § 112, 1st paragraph, is therefore not well founded and should be reversed.

II. Rejection under 35 U.S.C. § 112, 1st paragraph, for lack of written description

At page 4 of the Final Office Action, Claims 20-21, 23-26, 30 and 33 are rejected under 35 U.S.C. § 112, 1st paragraph, as failing to provide written description for “a computer-readable medium.” That rejection is also not well founded and should be reversed.

As an initial matter, the rejection of exemplary Claim 30 and its dependent claims under 35 U.S.C. § 112, 1st paragraph, for lack of written description is not well founded and should be reversed because, despite Appellants’ previous noting of the Examiner’s error, the Examiner has

failed to reject the language of exemplary Claim 30 as written. In the rejection, the Examiner asserts:

The claim(s) contains subject matter “a computer-readable medium” which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Examiner is in error in that exemplary Claim 30 recites “a computer-readable storage medium” rather than “a computer-readable medium.”

The rejection of exemplary Claim 30 and its dependent claims under 35 U.S.C. § 112, 1st paragraph, for lack of written description is also not well founded and should be reversed because the specification as originally filed clearly evidences that the inventors had possession of the claimed invention at the time the application was filed. As stated in MPEP2163.02 in relevant part:

Whenever the issue [of written description] arises, the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). ...

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. ...

In the present application, written description for the “computer-readable storage medium” can be found, for example, at page 8, line 30 *et seq.* of the present specification, which discloses:

Examples of computer usable mediums include: nonvolatile, hard-coded type mediums such as read only memories (ROMs) or erasable, electrically programmable read only memories (EEPROMs), recordable type mediums such as floppy disks, hard disk drives and CD-ROMs.

Thus, the present specification clearly discloses “computer usable mediums” on which data may be stored and from which data may be read. As noted, examples of such computer readable storage media include memories (e.g., ROMs, EEPROMs, etc.), magnetic storage media (e.g., floppy disks, hard disk drives, etc.) and optical storage media (e.g., CD-ROMs). Thus, while the present specification does not explicitly use the term “computer-readable storage medium” as recited in Claim 30, the present specification provides written description adequate to remove all doubt that “a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing.” *MPEP 2163*, citing *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116 and *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972)(stating “the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient”).

In view of the clear written description in the present specification supporting the recitation of a “computer-readable storage medium” in exemplary Claim 30, the rejection of exemplary Claim 30 and its dependent Claims 20-21, 23-26 and 33 under 35 U.S.C. § 112, 1st paragraph, is not well founded and should be reversed.

III. Rejection under 35 U.S.C. § 103

At page 5 of the Final Office Action, Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-30 are rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,661,632 to *Register* in view of U.S. Patent No. 6,453,173 to *Reber et al. (Reber)*. That rejection is not well founded and should be reversed.

A. Exemplary Claim 28

The combination of *Register* and *Reber* does not render exemplary Claim 28 unpatentable under 35 U.S.C. § 103 because that combination does not disclose the “analyzing” step set forth in Claim 28 as follows:

the portable device analyzing the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display.

With reference to this feature, page 5 of the Final Office Action cites Figures 4-5 of *Register*, claiming erroneously that “they are self[-]explanatory” and disclose the claimed step of “analyzing the data page to determine an orientation.” Appellants respectfully traverse the Examiner’s position because it is manifestly contrary to the plain teaching of the references. When the references are actually examined, it is clear that the combination of *Register* and *Reber* discloses:

Turning now to FIGS. 4 and 5, according to a primary aspect of the present invention, the handheld computer 10 is specially designed to be operated by a user in a selectively variable one of two different display screen orientations--a "portrait" orientation (FIG. 4) in which the length of the display screen 26 is vertically oriented, and a "landscape" orientation (FIG. 5) in which the length of the display screen is horizontally oriented and rotated ninety degrees in a counterclockwise direction from its FIG. 4 portrait orientation. [*Register*, col. 2, line 61 *et seq.*]

According to a key aspect of the present invention, to accommodate this reorientation of the computer 10 the orientation of its display screen image 52, as well as the command text and/or graphics C within the command icons 54a, 54b may be similarly rotated ninety degrees in a clockwise orientation using one of the toggle buttons 28, 30, 32 and 34 (representatively the toggle button 34). As may be seen by comparing FIGS. 4 and 5, this display reorientation causes both the display screen image 52 and the command text and/or graphics C to be in an "upright" viewing orientation when the computer is shifted from its FIG. 4 portrait orientation to its FIG. 5 landscape orientation. In a manner subsequently described herein the orientation of the display screen image 56 and the command text and/or graphics C may be also switched back to their FIG. 4 portrait orientation using the toggle button 34.

Register, col. 3, line 65 *et seq.*

In other words, the combination of *Register* and *Reber* discloses only that a user can toggle between portrait and landscape display modes using manually manipulable toggle buttons on a handheld computer 10. The combination of *Register* and *Reber* utterly fails to disclose, suggest or motivate a portable device analyzing a data page to determine the orientation of display for the data page. Consequently, the rejection of exemplary Claim 28, similar Claims 29-30 and their respective dependent claims under 35 U.S.C. § 103 in view of the combination of *Register* and *Reber* is not well founded and should be reversed.

B. Exemplary Claim 6

The rejection of exemplary Claim 6 under 35 U.S.C. § 103 in view of *Register* and *Reber* is similarly not well founded and should be reversed.

At page 8 of the Final Office Action, the Examiner asserts without any basis that the features recited in Claim 6 would have been obvious to those skilled in the art. Because the Examiner's unsupported assertion of obvious does not have any evidential weight, the Examiner has failed to make a *prima facie* case of obviousness with respect to Claim 6 or similar Claims 15 and 24, and the rejection of these claims under 35 U.S.C. § 103 should be reversed.

C. Exemplary Claim 7

The rejection of exemplary Claim 7 under 35 U.S.C. § 103 in view of *Register* and *Reber* is similarly not well founded and should be reversed.

At page 8 of the Final Office Action, the Examiner notes that *Register* fails to disclose a “wireless telephone” as recited in Claim 7, but instead discloses a personal digital assistant. Because the Examiner has failed to make a *prima facie* case of obviousness with respect to Claim 7, Applicant respectfully submits that the rejection of Claim 7 and similar Claims 16 and 25 under 35 U.S.C. § 103 should be reversed.

IV. Summary

The foregoing arguments demonstrate that the present claims are not unpatentable under 35 U.S.C. § 112, 1st paragraph, and further, are not rendered unpatentable under 35 U.S.C. § 103 by the combination of *Register* and *Reber*. Appellants therefore respectfully request the Board to reverse the rejection of each pending claim.

The fee for filing of an Appeal Brief has been submitted herewith. Please charge any additional fees that are required to IBM Corporation Deposit Account No. **09-0447**.

Respectfully submitted,

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CLAIMS APPENDIX

1. (cancelled)
2. The method of claim 28, wherein the data page is received over a wireless connection.
3. The method of claim 28, wherein the second orientation is a ninety-degree rotation of the first orientation.
4. The method of claim 28, wherein the first dimension and second dimension are orthogonal.
5. The method of claim 28, wherein:
the data page is initially displayed by the portable device in one of the first and second orientations;
the method further comprises the portable device redisplaying the data page in the other of the first and second orientations in response to a user input.
6. The method of claim 28, wherein:
the data page is initially displayed by the portable device in one of the first and second orientations;
the method further comprises the portable device automatically redisplaying the data page in the other of the first and second orientations after a preset duration.
7. The method of claim 28, wherein in the portable device is a wireless telephone.
8. The method of claim 28, wherein the portable device is a personal digital assistant.
- 9.-10. (cancelled)
11. The portable data processing system of claim 29, wherein the data page is received over a wireless connection.

12. The portable data processing system of claim 29, wherein the second orientation is a ninety-degree rotation of the first orientation.

13. (cancelled)

14. The portable data processing system of claim 29, wherein:
the portable data processing system initially displays the data page in one of the first and second orientations; and
the instructions further cause the data processing system to redisplay the data page in the other of the first and second orientations in response to a user input.

15. The portable data processing system of claim 29, wherein:
the data page is initially displayed by the portable data processing system in one of the first and second orientations;
the instructions further cause the data processing system to automatically redisplay the data page in the other of the first and second orientations after a preset duration.

16. The data processing system of claim 29, wherein the portable data processing system is a wireless telephone.

17. The data processing system of claim 29, wherein the portable data processing system is a personal digital assistant.

18.-19. (cancelled)

20. The computer program product of claim 30, wherein the data page is received over a wireless connection.

21. The computer program product of claim 30, wherein the second orientation is a ninety-degree rotation of the first orientation.

22. (cancelled)

23. The computer program product of claim 30, wherein:

the data page is initially displayed by the portable device in one of the first and second orientations;

the computer program product further includes instructions that cause the portable data processing device to redisplay the data page in the other of the first and second orientations in response to a user input.

24. The computer program product of claim 30, wherein:

the data page is initially displayed by the portable device in one of the first and second orientations;

the computer program product further includes instructions that cause the portable data processing device to automatically redisplay the data page in the other of the first and second orientations after a preset duration.

25. The computer program product of claim 30, wherein the portable device is a wireless telephone.

26. The computer program product of claim 30, wherein the portable device is a personal digital assistant.

27. (cancelled)

28. A method for displaying data on a portable device having a display that is significantly larger in a first dimension than in a second dimension, said method comprising the steps of:

receiving a data page in the portable device;

the portable device analyzing the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display; and

the portable device automatically displaying the data page in a first orientation within the display in response to determining the first orientation and the portable device automatically displaying the data page in a second orientation within the display in response to determining the second orientation.

29. A portable data processing system, comprising:
a processor;
memory coupled to the processor;
a display that is significantly larger in a first dimension than in a second dimension; and
instructions in the memory that, when processed by the processor, cause the portable data processing system to:

receive a data page in the portable data processing system;
analyze the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display; and
automatically display the data page in a first orientation within the display in response to determining the first orientation and automatically display the data page in a second orientation within the display in response to determining the second orientation.

30. A computer program product for use within a portable data processing device having a display that is significantly larger in a first dimension than in a second dimension, said computer program product comprising:

a computer-readable storage medium;
instructions embodied within the storage medium that cause the portable data processing device to receive a data page within the portable data processing device;
instructions embodied within the storage medium that cause the portable data processing device to analyze the data page to determine an orientation for presentation of the data page relative to the first and second dimensions of the display; and
instructions embodied within the storage medium that cause the portable data processing device to automatically display the data page in a first orientation within the display in response to determining the first orientation and to automatically display the data page in a second orientation within the display in response to determining the second orientation.

31. The method of Claim 28, wherein said analyzing comprises the portable device determining a line width of textual content of the data page.

32. The portable data processing system of Claim 29, wherein said instructions further cause the data processing system to analyze the data page by determining a line width of textual content of the data page.

33. The computer program product of Claim 30, wherein said instructions for causing the portable data processing device to analyze comprise instructions for causing the portable data processing device to determine a line width of textual content of the data page.

EVIDENCE APPENDIX

W3C, “HTML 4.01 Specification, W3C Recommendation,” December 24, 1999.

RELATED PROCEEDINGS APPENDIX

The present appeal is related to the following prior appeals of the present application:

- (1) The decision in Appeal No. 2004-1712, mailed January 28, 2005, which reversed the final rejection of Claims 2-8, 11, 12, 14-17, 20, 21, 23-26 and 28-30; and
- (2) The decision in Appeal No. 2009-003738, mailed August 31, 2009, which affirmed the final rejection of Claims 2-8, 11-12, 14-17, 20-21, 23-26 and 28-30.